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EXAMINER

PIZIALI, ANDREW T

ART UNIT	PAPER NUMBER
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1775

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13

Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 13

Application Number: 09/589,055
Filing Date: June 07, 2000
Appellant(s): RASMUSSEN ET AL.

Terry D. Morgan
For Appellant

MAILED

JUN 12 2003

GROUP 1700

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/2/2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 16-37 and 48-54 stand or fall together.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

5,982,082

JANNING

11-1999

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(10) Grounds of Rejection

The following grounds of objection and rejection are applicable to the appealed claims:

Claim Objections

1. Applicant is advised that should claims 31-37 be found allowable, claims 48-54 will be objected to under 37 CFR 1.75 as being substantial duplicates thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 16-37 and 48-54 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 5,982,082 to Janning.

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Janning discloses that it is known in art to produce field emission displays comprising glass substrates with an anode formed on the first surface of the glass substrate and a fluorescent material layer comprising phosphor particles applied to the anode surface (column 3, lines 34-49 and column 4, lines 3-9).

It is the examiner's position that the phosphor particle bound substrate disclosed by Janning is identical to or only slightly different than the phosphor particle bound substrate prepared by the method of the claims. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show obvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). Janning either anticipated or strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the phosphor particle bound substrate disclosed by Janning.

(11) Response to Argument

The Appellant asserts that the Examiner's position is that the patentability of the product does not depend on its method of production. The Examiner respectfully

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disagrees. It is the position of the Examiner that the patentability of the product does depend on its method of production, but it is also the position of the Examiner that phosphor particle bound substrate disclosed by Janning is identical to or only slightly different than the phosphor particle bound substrate prepared by the method of the current claims. In addition, it is the position of the Examiner that the appellant has failed to show a patentable distinction between the article disclosed by Janning and the currently claimed article.

The Appellant asserts that the product formed by the process disclosed in Janning cannot be substantially identical to the product formed by the Appellants' claimed process, because the two structures have substantially different properties such as the strength of the phosphor particle bonds to each other and to the substrate. The Examiner respectfully disagrees. The Examiner asserts that the Appellant has not demonstrated that the strength of the phosphor particle bonds to each other and/or to the substrate are different in the currently claimed article than they are in the article disclosed by Janning. Furthermore, the Examiner asserts that the Appellant has not even attempted to demonstrate that the strength of the phosphor particle bonds to each other and/or to the substrate are different in the currently claimed article than they are in the article disclosed by Janning.

The Appellant asserts that by removing the substrate from the binder solution at a predetermined rate the adherence of the phosphor particles to each other, as well as to the faceplate, is improved. The Appellant cites page 11, lines 15-19, of the current specification, to support this assertion. The Examiner asserts that the Appellant failed to

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disclose what the new adherence improves from, or what the new adherence is being compared to in reference.

Although the Appellant has not disclosed what the new adherence improves from, or what the new adherence is being compared to in reference, the Examiner has considered that the Appellant may be speaking of the improvement in adherence in reference to the disclosure on page 3, line 13 through page 4, line 9, of the current specification, in which the Appellant discloses two conventional methods that are used for applying a phosphor particle binder solution to a faceplate. The two conventional methods disclosed by the Appellant are spraying a binder solution onto a faceplate, and a spinning method in which a binder solution is poured onto a faceplate as the faceplate is spinning horizontally. The Examiner asserts that the teachings on page 11, lines 15-19, of the current specification, are not commensurate in scope with the teachings of Janning. The teachings do not mention either of the two methods disclosed by Janning, which are atomic layer epitaxy and vapor reaction technique (column 9, lines 16-21). The Examiner asserts that the specification is silent with regards to the difference in adherence between the currently claimed method of submerging the substrate covered with phosphor particles into a binder solution followed by removing the substrate at a predetermined rate, compared to the prior art methods of atomic layer epitaxy and vapor reaction technique.

MPEP Section 2113 states: “ “The Patent Office bears a lesser burden of proof in making out a case of *prima facie* obviousness for product-by-process claims because of their peculiar nature” than when a product is claimed in the conventional fashion. *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner

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provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983)."

It is the position of the Examiner that Appellant has failed to come forward with any evidence establishing an unobvious difference between the currently claimed product and the prior art product. The examiner notes that in *In re Marosi* the court upheld a rejection because the Appellant had not come forward with any evidence that the claimed product was not a different and unobvious product.

Finally, the current specification discloses that although one embodiment of the present invention comprises the use of the phosphor screening by electrophoresis process of submerging the substrate covered with phosphor particles into a binder solution followed by removing the substrate at a predetermined rate, the specification also discloses that the adherence of phosphor particles to the faceplate may be accomplished via alternative methods known to those of ordinary skill in the art, such as phosphor slurry process, dusting, electrostatic dusting, photo-tacky or settling processes (page 9, lines 1-18). The specification discloses that such a process for adhering the phosphor particles to the faceplate need not necessarily be limited to the phosphor screening by electrophoresis process (page 9, lines 17-18 and page 11, lines 8-9). The examiner asserts that Appellant's specification concedes that no patentable distinction lies between the method of binding the phosphor particles to the faceplate by the phosphor screening

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by electrophoresis process and the alternative methods known to those of ordinary skill in the art.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Andrew T Piziali
Examiner
Art Unit 1775



atp
June 10, 2003

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